

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/693,025	TORONTALI ET AL.	
	Examiner	Art Unit	
	Anna Skibinsky	1631	
The MAILING DATE of this communication			;
Period for Reply		:	
<ul> <li>A SHORTENED STATUTORY PERIOD FOR RE</li> <li>WHICHEVER IS LONGER, FROM THE MAILING</li> <li>Extensions of time may be available under the provisions of 37 CFF after SIX (6) MONTHS from the mailing date of this communication.</li> <li>If NO period for reply is specified above, the maximum statutory per</li> <li>Failure to reply within the set or extended period for reply will, by sta Any reply received by the Office later than three months after the m earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>	DATE OF THIS COMMUN R 1.136(a). In no event, however, may a riod will apply and will expire SIX (6) MO atute, cause the application to become A	ICATION. reply be timely filed NTHS from the mailing date of this communi BANDONED (35 U.S.C. § 133).	
Status		· .	
1) Responsive to communication(s) filed on _		:	
	his action is non-final.		
3) Since this application is in condition for allo	wance except for formal ma	ters, prosecution as to the meri	its is
closed in accordance with the practice under	er Ex parte Quayle, 1935 C.I	D. 11, 453 O.G. 213.	
Dispessition of Claims			
Disposition of Claims		:	
4) Claim(s) <u>1-19</u> is/are pending in the applicat			
4a) Of the above claim(s) is/are with	drawn from consideration.		
5) Claim(s) is/are allowed.			
<ul> <li>6) Claim(s) is/are rejected.</li> <li>7) Claim(s) is/are objected to.</li> </ul>		;	
8) Claim(s) <u>1-19</u> are subject to restriction and/	for election requirement		
		:	
Application Papers		:	
9) The specification is objected to by the Exam	niner.		
10) The drawing(s) filed on is/are: a)			
Applicant may not request that any objection to			
Replacement drawing sheet(s) including the cor			
11) The oath or declaration is objected to by the	e Examiner. Note the attache	d Office Action or form PTO-15	2.
Priority under 35 U.S.C. § 119			
12) Acknowledgment is made of a claim for fore a) All b) Some * c) None of:	ign priority under 35 U.S.C.	§ 119(a)-(d) or (f).	
1. Certified copies of the priority docum	ents have been received.		
2. Certified copies of the priority docum		Application No	
3. Copies of the certified copies of the p			е
application from the International Bur	reau (PCT Rule 17.2(a)).		
* See the attached detailed Office action for a	list of the certified copies no	t received.	
Attachment(s)			
1) Notice of References Cited (PTO-892)	4) 🗍 Interview	Summary (PTO-413)	
2) 🔲 Notice of Draftsperson's Patent Drawing Review (PTO-948)		(s)/Mail Date.	
<li>3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB Paper No(s)/Mail Date</li>	/08) 5) [ Notice of 6) [ Other:	Informal Patent Application (PTO-152)	
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## DETAILED ACTION

#### Election/Restrictions

1. Restriction to one of the following inventions is required under 35 USC 121:

I. Claims 1-18, drawn to a method for amplifying a signal for detection of a polynucleotide where a pre-optimized oligonucleotide is linked to a microsphere, drawn to class 436, subclass 6.

II. Claim 19, drawn to a method of optimizing an oligonucleotide hybridization-based assay, drawn to class 436, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and II are directed to related different inventions. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j).

3. In the instant case, the Groups are independent or distinct because Group I entails linking oligonucleotides to microspheres while Group II, is an array of oligoncucleotides which does not involve the microspheres. Group I and II are further distinct in that Group II entails identifying an optimal oligonucleotide from the fingerprint via an algorithm while Group I uses an algorithm to select a pre-optimized oligonucleotide. The selection of the optimal oligonucleotide of Group II includes the

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step of subjecting an optimal oligonucleotide to an oligonucleotide hybridization-based assay. Thus, the subject matter of Group I and II are drawn to different inventions and the search for both Groups together would be an undue search burden as they are directed to methods that are generally distinct and separate.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Skibinsky whose telephone number is (571) 272-4373. The examiner can normally be reached on 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anna Skibinsky, PhD

ANDREWV VISORY PATENT EXAMINER

TECHNOLOGY CENTER 1600